

## REMARKS

This Response is submitted in response to the Notice of Non-responsive Amendment mailed on January 25, 2010, and in accordance with the telephone interview conducted on February 11, 2010. Claims 1 to 54 remain cancelled. Claims 55 to 90 remain pending. Please charge Deposit Account No. 02-1818 for any fees due in connection with this Response.

The Notice of Non-responsive Amendment states that:

[n]ewly submitted claims 55-90 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claimed invention as originally presented and examined was broadly directed to a symbol bearing display device incorporating the display elements, which as further claimed in dependent claims are defined to include symbol rotation, illumination, LCD, OLED type display technologies and associated capabilities of the preceding elements. The newly presented claims of October 12th, 2009 however present a display structure similar to the display structure paraphrased above and further in addition thereto incorporate a processor and memory device specifically programmed to perform a particular mode of operation including the receipt of a wager, causing a display device display a plurality of symbols, temporarily rotate the first display device, illuminate the symbols on the display device with an illumination device, and award a prize based on the symbols shown the display device. The original presented invention did not address the particular claimed mode of operation and could have been utilized with various known particular game methods including non-wager game play. However the product and method as defined in the claims of October 12th, 2009, commonly require the placement of a wager included with the various other method steps recited above and [therefore] include the incorporation differing modes of operation and functions, which resultant thereof define a separate claimed invention that was not originally presented (page 2) (emphasis added).

Applicant respectfully disagrees. Prior to originally filed Claims 1 to 17 being examined on their merits, Applicant filed two Preliminary Amendments. In the Preliminary Amendment filed on October 13, 2004, Applicant canceled Claims 1 to 17, added Claims 18 to 32 directed to a display device, and added Claims 33 and 34

directed to an entertainment machine. In the Preliminary Amendment filed on November 1, 2004, Applicant added Claims 35 to 54 directed to an entertainment machine.

Independent Claim 35 recites “[a]n entertainment machine operable to receive monetary value from a player, the entertainment machine comprising: ... an award available to the player when the successful outcome occurs, the award being at least partially based on the monetary value provided by the player” (emphasis added).

Independent Claim 41 recites “[a]n entertainment machine controlled by a processor, the entertainment machine operable to receive monetary value from a player, the entertainment machine comprising: ... an award available to the player when the successful outcome occurs, the award being at least partially based on the monetary value provided by the player” (emphasis added). Dependent Claim 47 recites “a data storage device accessible by the processor, the data storage device storing data which is associated with different displays produced by each one of the signal-actuable devices, each of said displays including a designated sequence of designated ones of the symbols” (emphasis added).

Independent Claim 48 recites “[a]n entertainment machine operable to receive monetary value from a player, the entertainment machine comprising: ... an award available to the player when the successful outcome occurs, the award being at least partially based on the monetary value provided by the player” (emphasis added). Dependent Claim 49 recites “a processor operatively coupled to the motor and the signal-generating device, the processor synchronizing the simulated movement of the symbols with the movement of the exposed portion of the movable member” (emphasis added).

As discussed during the telephone interview, to advance the prosecution of this application, Applicant canceled Claims 18 to 54 and added Claims 55 to 90. That is, Applicant added Claims 55 to 90 to reorganize certain of the elements and structure previously claimed in Claims 18 to 54 (now canceled). Support for Claims 55 to 90 can be found at least in paragraphs [0015], [0024], [0026], [0033], and [0055] to [0059] along with Figs. 3 to 5 of Applicant's specification.

During the telephone interview, Applicant pointed out various similarities between Claims 18 to 54 (now canceled) and Claims 55 to 90. For example, the gaming device of independent Claim 55 or 73 receives a wager from a player for a play of a wagering game which is similar to the monetary value provided by the player of independent Claims 35, 41 and 48 (now canceled). Additionally, similar to the processor and the data storage device accessible by the processor of Claims 41 and 47 (now canceled), the gaming device of independent Claims 55 and 73 each generally include, among other elements, a processor and a memory device which stores a plurality of instructions for a play of a wagering game.

Because of the similarities noted above between Claims 35, 41, 47, 48 and 49 (now canceled) and at least independent Claims 55 and 73, Applicant respectfully submits that Claims 55 to 90 are not independent and distinct from Claims 35 to 54 (now canceled). Thus, contrary to the Notice of Non-responsive Amendment mailed on January 25, 2010, Applicant respectfully submits that Claims 55 to 90 should not be withdrawn from consideration as being directed to a non-elected invention.

Further, the Notice of Non-responsive Amendment mailed on January 25, 2010 appears to mischaracterize Claims 55 to 90 as being directed to an apparatus having method (or functional) steps to indicate the intended use of the apparatus, whereas original Claims 1 to 54 (now canceled) were directed to an apparatus. Specifically, page 2 of the Notice of Non-responsive Amendment states "the product and method as defined in the claims of October 12th, 2009, commonly require the placement of a wager included with the various other method steps recited above and [therefore] include the incorporation differing modes of operation and functions, which resultant thereof define a separate claimed invention that was not originally presented" (emphasis added). During the telephone interview, Applicant respectfully disagreed with this line of reasoning.

Applicant submits that such a line of reasoning is completely contrary to the law and MPEP §2106.01. The United States Supreme Court recently addressed this issue in discussing the distinction between hardware standing alone and hardware combined with software. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007), 127 S. Ct. 1746. In *Microsoft Corp.*, the United States Supreme Court explained that once a piece of

computer hardware was loaded with specialized software, the computer hardware was transformed to include the software's distinctive functionality that infringed a patented speech processor, while the hardware standing alone did not infringe. *Microsoft Corp.*, 127 S. Ct. at 1750. The software functionality gave patentable weight to the combined hardware and software and thus the software functionality had to be present for infringement to be found. Specifically, the United States Supreme Court stated:

AT&T's patent ('580 patent) is for an apparatus (as relevant here, a computer) capable of digitally encoding and compressing recorded speech. Windows, the parties agree, contains software that enables a computer to process speech in the manner claimed by the '580 patent. In 2001, AT&T filed an infringement suit in the United States District Court for the Southern District of New York, charging Microsoft with liability for domestic and foreign installations of Windows.

Neither Windows software (e.g., in a box on the shelf) nor a computer standing alone (i.e., without Windows installed) infringes AT&T's patent. Infringement occurs only when Windows is installed on a computer, thereby rendering it capable of performing as the patented speech processor.

Appellant further submits that the Court in *In re Lowry* held that:

[t]here is one further rationale used by both the board and the examiner, namely, that the provision of new signals to be stored by the computer does not make it a new machine, i.e. it is structurally the same, no matter how new, useful and unobvious the result. . . . To this question we say that if a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. 32 F.3d at 1583 (citing *Bernhart*, 417 F.2d at 1400) (emphasis added).

In other words, how a machine is coded provides structural differentiation from other machines. Applicant therefore submits that the Examiner may not ignore the features of the processor and the memory device of the gaming device of independent Claim 55 or independent Claim 73.

Likewise, the Federal Circuit has clearly held that a general purpose computer becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994). The Federal Circuit held that such programming of a general computer creates a new machine. *In re Alappat*, 33 F.3d at 1545. That is, computers including the same or similar hardware configurations that are coded in different ways (i.e., with software), creates specific purpose computers that are patentably different from each other. Thus, it must be the functionality of the software, or the functionality that the software gives the hardware which provides the patentability (i.e., the novelty and non-obviousness over the prior art). Accordingly, the apparent view (taken by the Notice of Non-responsive Amendment) that Claims 55 and 73 each recite method (or functional) steps is clearly not in accordance with the law of the United States Supreme Court and the Federal Circuit.

The Examiner should appreciate the Federal Circuit's recognition in the gaming field in *WMS Gaming, Inc. v. IGT*, 184 F.3d 1339, 1348 (Fed. Cir. 1999) that "a general purpose computer, or microprocessor, programmed to carry out an algorithm creates "a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." (citing *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (en banc); see *In re Bernhart*, 57 C.C.P.A. 737, 417 F.2d 1395, 1399-1400 (CCPA 1969) ("If a machine is programmed in a certain new and unobvious way, it is [<sup>\*\*20</sup>] physically different from the machine without that program; its memory elements are differently arranged."). The instructions of the software program that carry out the algorithm electrically change the general purpose computer by creating electrical paths within the device. These electrical paths create a special purpose machine for carrying out the particular algorithm.).

Accordingly, all of the features of the gaming device of independent Claim 55 (and dependent Claims 56 to 72) must be accorded patentable weight. Similarly, all of the features of the gaming device of independent Claim 73 (and dependent Claims 74 to 90) must be accorded patentable weight.

For at least the above reasons, and the reasons set forth in the Response to Office Action filed on October 27, 2009, Applicant respectfully submits that Claims 55 to 90: (i) should not be withdrawn from consideration as being directed to a non-elected invention, and (ii) are patentably distinguished over Griswold and Loose and in condition for allowance.

A *bona fide* attempt has been made to advance the prosecution of this application. Should the Examiner believe that a Request for Continued Examination is necessary to advance the prosecution of this application or should the Examiner have any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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